

**REMARKS**

In the Office Action mailed July 21, 2008 from the United States Patent and Trademark Office, claims 1, 3-6, 12-13, 15-19, 20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0267876 to Kakivaya et al. (hereinafter “Kakivaya”) in view of U.S. Patent Application Publication No. 2005/0090242 to Kotzin et al. (hereinafter “Kotzin”), claims 10 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of U.S. Patent Application Publication No. 2004/0054807 to Harvey et al. (hereinafter “Harvey”), claims 2, 11, 14, 21, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of U.S. Patent Application Publication No. 2002/0045435 to Fantaske (hereinafter “Fantaske”), and claims 7-9 and 25-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of U.S. Patent Application Publication No. 2004/0064575 to Rasheed et al. (hereinafter “Rasheed”). In the Office Action, it was also indicated that the Section 131 Declaration was considered ineffective to overcome Kotzin.

Applicant respectfully provides the following:

**Rejections under 35 U.S.C. § 103(b):**

In the Office Action, claims 1, 3-6, 12-13, 15-19, 20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya in view of Kotzin, claims 10 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of Harvey, claims 2, 11, 14, 21, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of Fantaske, and claims 7-9 and 25-27 were

rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakivaya and Kotzin in view of Rasheed.

Each of the rejections relies in part on Kotzin. Kotzin matured from an application filed on October 24, 2003. The instant application was filed on January 14, 2004. Applicant previously submitted a declaration by Michael F. Krieger that was considered by the Office to be insufficient to overcome the Kotzin reference because it lacked sufficient evidence to overcome the reference. Submitted herewith, please find a new declaration by Michael F. Krieger under 37 C.F.R. § 1.132 that includes evidence of conception and diligence from a date prior to the effective date of Kotzin to the date of constructive reduction to practice of the filing of the instant application. Also submitted herewith is a declaration by the inventor, Sachin Govind Deshpande under 37 C.F.R. § 1.131 that includes evidence of conception and diligence from a date prior to the effective date of Kotzin to the date of constructive reduction to practice upon the filing of the instant application. Therefore, Kotzin is not prior art under 35 U.S.C. § 102(e), and all rejections dependent thereon should be removed.

The invention disclosure document included in both Declarations is dated and signed by the inventor and two witnesses on July 16, 2002. The disclosure document shows conception of the invention as early as July 16, 2002, and at least no later than August 13, 2003 when the letter forwarding the disclosure document was sent to Kirton & McConkie for preparation of the instant patent application. Therefore, the Renewed Declaration provides sufficient evidence of conception.

The Declaration by Mr. Krieger also provides evidence of diligence between August 13, 2003 and the filing date of the instant application on January 14, 2004. As may be seen from the letter attached to the Declaration at Exhibit A, three invention disclosures were simultaneously

forwarded to Kirton & McConkie by the assignee on August 13, 2003 and were received on August 20, 2003. Preparation of the three applications began in late August 2003. See Exhibits C, E, and F, which are true copies of a part of the file histories maintained by Kirton & McConkie's document management system for the Word-editable application files for the applications. (Declaration of Mr. Krieger, paragraphs 7 and 9.)

A portion of the preparation process included forwarding of an invention summary disclosure for all three applications, which was forwarded to the assignee for review on September 2, 2003. Declaration of Mr. Krieger, paragraph 6, Exhibit B. All three applications were edited in September 2003, and copies were mailed for review in late September 2003. See Exhibits C, E, and F. The evidence showed that the review process occurred serially, with the other two applications completing the review process first. The first application review process culminated in the filing of U.S. Application Serial No. 10/712,241 on November 13, 2003 after review and editing in October 2003. Declaration of Mr. Krieger, paragraph 9 and Exhibit E. The second application review process culminated in the filing of U.S. Application Serial No. 10/738,475 on December 17, 2003 after review and editing in December 2003. Declaration of Mr. Krieger, paragraph 9 and Exhibit F.

As is illustrated by Exhibit D, the review process for the applications included e-mail and post correspondence between the parties, which involved some time. Declaration of Mr. Krieger, Ex. D. Thus, the instant application was filed after diligent work and review for all three applications and after filing of the other two applications. Declaration of Mr. Krieger, paragraphs 7-11 and Exhibits C and D.

The above facts are also supported by the Declaration of the inventor. The inventor attests to the date of conception as supported by the dated and signed invention disclosure.

Declaration of Mr. Deshpande, paragraph 3 and Ex. A. The inventor declares that he diligently participated in the preparation, review, and revision process for all three applications in serial fashion between the time when the invention disclosures were forwarded to Kirton & McConkie until the date of filing of the instant application. Declaration of Mr. Deshpande, paragraphs 5-8. As the inventor indicates, the preparation, review, and revision process occurred serially with his diligent participation within the constraints of his other work duties.

The above facts show diligence in preparing, reviewing/revising, and approving the patent application from a time prior to the filing of Kotzin until the filing of the instant application. Conception is also shown at least as early as the receipt of the complete disclosure document. As set forth in the M.P.E.P., the diligence of an attorney in preparing and filing the patent application inures to the benefit of the inventor. (M.P.E.P. § 2138.06) The M.P.E.P. also sets forth that showing work on related cases and/or work on a backlog of unrelated cases taken up in chronological order is sufficient to show diligence. (M.P.E.P. § 2138.06) As this is what has been shown in the attached Declarations, Applicant respectfully submits that prior invention by Applicant has been shown, and that Kotzin is therefore not prior art. Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 103(a) relying on Kotzin, which includes all rejections under 35 U.S.C. § 103(a).

In addition, M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that

“the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.)

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Specifically, regarding claims 2, 11, 14, 21, and 29, the claims were rejected in part over Fantaske, with the Office Action indicating that Fantaske teaches using a randomized exponential backoff strategy. Applicant respectfully traverses the rejections of claims 2, 11, 14, 21, and 29 for similar reasons to those discussed previously with respect to the prior rejections over Peters.

Specifically, Applicant respectfully notes that claim 1 recites a method for the client discovering and connecting to the server that comprises “initiating a request at the client to discover the server.” Claim 2 further requires “wherein the request [to discover the server] is further made using a randomized exponential backoff strategy.” The limitations of the other cited claims are similar. Applicant respectfully submits that while Fantaske teaches an exponentially-larger random-backoff interval, Fantaske does not teach a request to discover a server made using a randomized exponential backoff strategy. Fantaske teaches that the exponentially-larger random-backoff delay is utilized to determine when it is safe to transmit a

message to an access point. (Para. [0037]) However, it is apparent that the wireless terminal has already discovered the access point in Fantaske: Fantaske teaches that the wireless terminal uses the presence of the carrier signal produced by the access point to determine whether the access point is communicating with another wireless terminal. (Para. [0037]) Therefore, in Fantaske, the wireless terminal is already aware of the access point and merely uses the random-backoff delay to reduce the likelihood that multiple wireless terminals will attempt to simultaneously communicate with the same access point, not to initiate a request to discover the server. (Para. [0037]) Thus Fantaske fails to teach the claim limitation of claim 2 of “wherein the request [to discover the server] is further made using a randomized exponential backoff strategy.” Claims 11, 14, 21, and 29 recite similar limitations. Claims 2, 11, 14, 21, and 29 are therefore allowable for at least this additional reason.

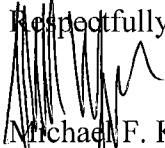
For at least the above reasons, Applicant respectfully submits that all rejections under 35 U.S.C. § 103(a) have been overcome, and respectfully requests the removal of such rejections.

**CONCLUSION**

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 21<sup>st</sup> day of October, 2008.

Respectfully submitted,

  
Michael F. Krieger  
Attorney for Applicant  
Registration No.: 35,232

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Facsimile: (801) 321-4893